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EXAMINER

ENG, G

ART UNIT

PAPER NUMBER

2743

DATE MAILED:

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

09/141,318

Applicant(s)

Isomura

Examiner

George Eng

Group Art Unit

2743

☒ Responsive to communication(s) filed on May 30, 2000☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claim

- ☒ Claim(s) 1-38 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-38 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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**DETAILED ACTION**

***Response to Amendment***

1. This Office action is in response to the amendment filed 5/30/2000 (paper no. 6).

***Claim Rejections - 35 U.S.C. § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (US PAT. 5,757,891) in view of Murakami et al. (US PAT. 5,590,178 hereinafter Murakami).

Regarding claim 1, Wang discloses a telephone 200 with an electronic mail managing function, wherein the telephone comprising accessing means for accessing to a mail server (col. 12 lines 9-13), a mail memory for storing an electronic mail received from the mail server (col. 12 lines 14-17) and transmission means 21 for transmitting the electronic mail store in the mail memory to one of the plurality of terminal devices (figure 2 and col. 4 line 66 through col. 5 line 45). Wang differs from the claimed invention in not specifically teaching memory status means for storing each status of the electronic mail store in the mail memory so as to correspond to each of the terminal device. However,

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Murakami teaches an electronic mail system having a user status variable table, i.e., memory status means, for providing a history of user activities performed on the electronic mail system (figure 4 and col. 4 line 57 through col. 5 line 3). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Wang in having memory status means, as per teaching of Murakami, because it provides a user friendly so that it provides a history of users' activities performed on the system.

Regarding claims 2-3, Murakami discloses the mail status memory means storing whether or not the electronic mail is received at each of terminal devices and a table for storing a process to be applied to the electronic mail for each of terminals (figure 4 and col. 4 lines 57-59).

Regarding claim 4, Murakami discloses the process to be applied to the electronic mail including to delete and to keep the electronic mail (col. 10 lines 31-35).

Regarding claim 5, Wang teaches the telephone further comprising emergency process means for determining whether a priority is necessary (col. 9 lines 7-20).

Regarding claim 6, Wang teaches an identifier memory for storing an identifier of a device to be connected so that it is permitted to access from the device of which the identifier coincides with the stored identifier (col. 7 line 64 through col. 8 line 12).

Regarding claim 7, Wang disclose a method in a mail managing apparatus 200 for transmitting and receiving mail data to and from a mail server 202 and a plurality of terminal devices as shown in figure 10 comprising a reading step of reading a mail stored in the mail server (col. 12 lines 9-13), a storing step for storing the mail in the reading step (col. 12 lines 14-17), a display step for

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displaying a status of the mail stored in the storing step (col. 12 lines 18-23), and a transmission step of transmitting the mail stored in the storing step to one of the terminal devices (col. 12 lines 34-39). Wang differs from the claimed invention in not specifically teaching to display a status of the mail for each of the terminal devices. However, Murakami teaches such (figure 4 and col. 4 line 57 through col. 5 line 3). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Wang in having memory status means, as per teaching of Murakami, because it provides a user friendly so that it provides a history of users' activities performed on the system.

Regarding claim 8, the limitations of the claim are rejected as the same reasons set forth in claim 7.

4. Claims 9, 16-17, 24, 31 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (US PAT. 5,757,891) in view of Brunson (US PAT. 5,781,614).

Regarding claim 9, Wang discloses an e-mail apparatus as shown in figure 2 comprising a receiving unit for receiving an electronic mail from a mail server (col. 5 lines 2-6), and a mail memory unit for storing the received electronic mail (col. 5 lines 58-59), wherein the e-mail apparatus is capable of communicating with a plurality of terminal devices comprising a transmitting unit for transmitting the electronic mail stored in the mail memory unit to one of plurality of terminal devices (col. 5 lines 32-39 and col. 6 lines 58-67). Wang differs from the claimed invention in not specifically teaching that the e-mail apparatus transmitting the electronic mail stored in the mail memory in

response to an access by one of said plurality of terminal devices. However, it is well known in the art of transmitting the electronic mail stored in the mail memory in response to an access by one of said plurality of terminal devices, for example see Brunson, because it improves security of the apparatus dealing with electronic mails.

Regarding claim 16, Wang teaches that the e-mail apparatus is provided in a telephone for (figure 2 and col. 6 lines 10-32).

Regarding claims 17, 34 and 31, the limitations of the claims are rejected as the same reasons set forth in claim 9.

Regarding claim 38, the limitations of the claim are rejected as the same reasons set forth in claim 16.

5. Claims 10-15, 18-23, 25-30 and 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (US PAT. 5,757,891) in view of Brunson (US PAT. 5,781,614) as applied in claims above, and further in view of Murakami et al. (US PAT. 5,590,178 hereinafter Murakami).

Regarding claim 10, the combination of Wang and Brunson differs from the claimed invention in not specifically teaching memory status means for storing each status of the electronic mail store in the mail memory so as to correspond to each of the terminal device. However, Murakami teaches an electronic mail system having a user status variable table, i.e., memory status means, for providing a history of user activities performed on the electronic mail system (figure 4 and col. 4 line 57 through col. 5 line 3). Therefore, it would have been obvious to a person of ordinary skill in the art at the time

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the invention was made to modify the combination of Wang and Brunson in having memory status means, as per teaching of Murakami, because it provides a user friendly so that it provides a history of users' activities performed on the system.

Regarding claim 11, Murakami discloses the mail status memory means storing whether or not the electronic mail is received at each of terminal devices and a table for storing a process to be applied to the electronic mail for each of terminals (figure 4 and col. 4 lines 57-59).

Regarding claim 12, Murakami discloses process specifying means for specifying how the electronic mail transmitted to the terminal device (col. 10 lines 31-35).

Regarding claim 13, Wang discloses the e-mail apparatus comprising means for receiving electronic mail from each terminal device and for transmitting the received electronic mail to the service (figure 2).

Regarding claim 14, Wang teaches the telephone further comprising emergency process means for determining whether a priority is necessary (col. 9 lines 7-20).

Regarding claim 15, Wang teaches an identifier memory for storing an identifier of a device to be connected so that it is permitted to access from the device of which the identifier coincides with the stored identifier (col. 7 line 64 through col. 8 line 12).

Regarding claims 18-23, the limitations of the claims are rejected as the same reasons set forth in claims 10-15.

Regarding claims 25-30, the limitations of the claims are rejected as the same reasons set forth in claims 10-15.

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Regarding claim 32-37, the limitations of the claims are rejected as the same reasons set forth in claims 10-15.

### *Response to Arguments*

6. Applicant's arguments filed 5/30/2000 (paper no. 6) have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the present invention is the organized with the relationship between three elements, namely, mail managing terminal, mail server and terminals) are not recited in the prior art. However, Wang clearly shown a mail managing apparatus connected to a mail server for receiving mails via a phone line and having an interface 22 for transmitting data to and from terminals (see rejection above). Note while the claimed invention does not clearly define how the mail managing terminal operating to access the mail server and transmitting e-mail stored in the memory to one of terminals. Thus, the broadly claims can be still rejected by the prior art.

### *Conclusion*

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**8. Any response to this final action should be mailed to:**

**Box AF**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 308-6306, (for formal communications; please mark "EXPEDITED  
PROCEDURE")

**Or:**

(703) 308-6296 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is (703) 308-9555. The examiner can normally be reached on Tuesday to Friday from 7 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

GEORGE ENG

August 10, 2000

  
CURTIS A. KUNTZ  
SUPERVISORY PATENT EXAMINER  
GROUP 2700